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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/872,659 06/10/97 NAGY

S 016199/1110

EXAMINER

IM62/0512

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ART UNIT

PAPER NUMBER

1713

DATE MAILED:

05/12/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**08/872,659**

Applicant(s)  
**Nagy et al.**

Examiner  
**Roberto Rabago**

Group Art Unit  
**1713**



☒ Responsive to communication(s) filed on Feb 22, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 21-70 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 21-70 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 8

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

1. Receipt of amendment to the specification, a new declaration and power of attorney, cancellation of claims 1-20, presentation of new claims 21-70, a terminal disclaimer and an IDS filed 2/22/99 are acknowledged.

2. Objections to the declaration and to the specification are withdrawn.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 21-70 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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✓a) New claims 21, 36 and 52 each allow L to be a C<sub>1-16</sub> alkyl substitution. The disclosure as filed provides no basis for these species, and the limitation is deemed to be new matter.

✓b) New claims 21, 36 and 52 each allow L to be a naphthalene derivative containing no ring nitrogen (second drawn structure for L). The disclosure as filed provides no basis for these species, and the limitation is deemed to be new matter.

✓c) New claim 52 includes a limitation that three specific compounds are excluded. The disclosure as filed provides no basis for this exclusion, and the limitation is deemed to be new matter.

*Claim Rejections - 35 USC § 103*

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 21-70 are rejected under 35 U.S.C. 103(a) as being obvious over Nagy et al. 5,637,660.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e).

This rejection under 35 U.S.C. 103(a) might be overcome either by a showing under 37

CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the

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inventor of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application of any unclaimed subject matter prior to the effective U.S. filing date of the reference under 37 CFR 1.131.

The reference discloses and claims a catalyst and a method of polymerization which fully meet the content of each instant claim (col. 2-4, Examples 1-4). While not all species are exemplified, patentee provides clear direction in the structure of the catalyst and in the method of polymerization.

Applicant's arguments filed 2/22/99 have been fully considered but they are not persuasive. The instant claims comprise the bulk of the subject matter disclosed and claimed in the reference, and further include new species not disclosed in the reference. Rather than limiting the current claims to species not disclosed in the reference, applicants have claimed material which was fully disclosed in the reference and have re-claimed subject matter already claimed in the reference. Although applicants have argued in Paper No. 7 that the new species are not obvious over the reference, such argument is ineffective because the claims comprise genera containing the reference species and the new species. A species anticipates a genus. *In re Slater*, 276 F.2d 408, 411, 125 USPQ 345, 347 (CCPA 1960), *In re Gostelli*, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989).

Applicants have further argued that no rejection under 35 U.S.C. 103 can be maintained in light of common ownership, citing 35 U.S.C. 103© (Paper No. 7, pg. 17, second full paragraph). However, the statute applies to subject matter which qualifies as prior art under only 35. U.S.C.

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102 (f) or (g). Applicants have stated in Paper No. 7 that the new species not disclosed in the parent are not obvious over those of the reference (pg. 14, last paragraph, through pg. 17, line 3). Accordingly, the new species are not entitled to the filing date of the parent application, and the reference qualifies as prior art under 35 U.S.C. 102(e)/103.

### *Conclusion*

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rob Rabago whose telephone number is (703) 308-4347. The examiner can normally be reached from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful and the matter is urgent, the examiner's supervisor, James Seidleck, can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are:

(703) 305-5408 (official), (703) 305-3599 (official after final) and (703) 306-3429 (unofficial).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

RR

May 10, 1999

*David W. Wu*  
DAVID W. WU  
PRIMARY EXAMINER  
GROUP 1500